

REMARKS

In the November 3, 2005 Office action, Examiner Loke has indicated that claims 7-12 are allowed. In a telephone interview prior to the filing of the previous amendment on August 22, 2005, the examiner assured the attorney for applicants that claim 13 would be allowed by amending it to incorporate the word 'pre-wired' from claim 14. However, after claim 13 was amended to include the subject matter of claim 14, the examiner issued another office action in which claims 13 and 17 were rejected as anticipated by the Schulz et al reference (EP 0 271 596).

By this current amendment, the applicants have again amended claim 13 and dependent claim 17 and respectfully submit that the claims are now allowable.

It is important to recognize that the Schulz European patent is dealing with dynamic wiring between a plurality of integrated circuit components on a VLSI chip. On the other hand, the present invention deals with a single integrated circuit component within a VLSI chip. The current amendment to claim 13 is intended to focus more clearly on this difference. It points out that the dynamic wiring is within a single IC component, unlike Schulz in which the wiring is between different IC components on the chip. Thus, it is clear that the referenced patent cannot serve as an anticipation of claim 13 as now worded. Schulz does not now disclose each and every limitation of claim 13, nor does it describe the present invention with the degree of sufficiency that is required to enable one skilled in the art to practice the instantly claimed invention. In order for a printed publication to serve as a reference under 35 USC 102(b), it must enable the invention. The Federal Circuit court has stated "...Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling." see In re Donohue, 766 F.2d 531,533 (Fed. Cir. 1985). Furthermore, the same court has held: "A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference....In addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." See In re Paulsen, 30 F. 3rd 1475, 1478 (Fed Cir. 1994). As stated in Advanced Display System Inc., v. Kent State University, 54 USPQ2d 1673, 1679 (Fed

Cir. 2000), "...invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation." Applicants respectfully submit that the skilled practitioner would be unable to replicate the teachings of claim 13 by relying solely on the teachings of Schulz.

Applicants further rely on statements that were previously included in the amendment that was filed on May 27, 2005. This earlier amendment stated the following, on page 11: "In addition, although Schulz et al and the present invention share commonality of language, they are directed to different inventive concepts. A close reading of Schulz et al shows that it refers to the 'arrays' particularly in claim 13 as "...having formal functions, and existing during processing for design purposes and being resolvable in the final design stage." Thus, these arrays of Schulz can hardly be considered as a "field programmable gate array" as described in applicants' description. Furthermore, Schulz describes a partition comprised of a number of different electrical elements and arrays. Nowhere does the patent describe a programmable gate array of the type being used by applicants. Again, this is a distinction between the content of applicants' claim 13 and the subject matter of the Schulz patent. Accordingly, an anticipation rejection is not proper and should be withdrawn.

Applicants have now amended claim 17, and respectfully submit that the amendment places this claim in condition for allowance. The rejection of claim 17 as unpatentable over the single reference, Schulz, under 35 USC §103(a) should now be withdrawn. For an obviousness rejection, it is not enough that one may modify a reference, but rather it is generally necessary that a second reference suggest such modification of the first reference.

The CAFC stated in In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

"The Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". Citing In re Warner, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967)."

The law is quite clear that in order for a claimed invention to be rejected as obvious, the prior art must suggest the modifications sought to be patented. See In re Gordon, 221 U.S.P.Q. 1125, 1127 (CAFC 1984); ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (CAFC 1984). The foregoing principle of law has been followed in Aqua-Aerobic Systems, Inc. v. Richards of Rockford, Inc., 1 U.S.P.Q. 2d, 1945 (D.C. Illinois 1986). In the Aqua-Aerobic Systems, Inc. case, the Court stated that the fact that a prior reference can be modified to show the claimed invention does not make the modification obvious unless a prior reference suggests the desirability of the modification.

In In Re Oetiker, 24 U.S.P.Q. 2nd 1443, 1445 (CAFC 1992), the court held:

“There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.”

Where an individual reference does not teach the entire invention, then the modification which the invention represents must be suggested and motivated by some other reference or through some objective teaching and cannot come from the application itself. However, in the present rejection, the examiner has cited a single reference. Hence, there clearly can be no suggestion of modification gleaned from a secondary reference, but instead the modification rests solely on the suggestion by the Examiner based on applicants' own disclosure.

Claim 17 now specifies that the mass of each of the slices is identical. To infer from the teachings of Schulz that the differing porosities of the slices would affect their ultimate size is conjectural at best. Instead, the examiner has chosen only those portions of the Schulz disclosure that might tend to lend support to his position, while ignoring the fact that Schulz is directed to dynamic wiring between integrated circuit components whereas the focus of applicants' claims is the wiring through a single integrated circuit. In the case of In re Wesslau, 353 F. 2d 238 (CCPA 1965), the court held:

“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (emphasis original)

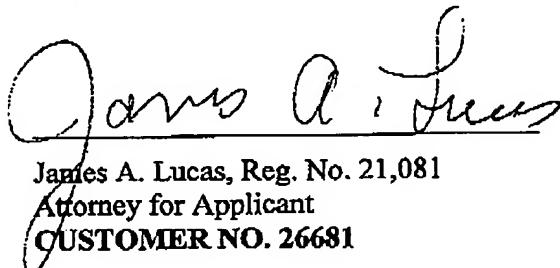
Similarly, in Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. et al, 796 F.2d 443, 230 U.S.P.Q 416 (Fed. Cir. 1986), the court held:

"The ... court failed to consider the Caddell reference in its entirety and thereby ignored the portions of the reference that argued against obviousness." (citations omitted)

Thus, it is clear that when a reference is used in a §103 citation, the entire reference must be used. One may not pick and choose from a given reference only those portions which support an espoused position, and ignore those portions which do not support that position. Based upon the foregoing, applicants respectfully request that the examiner withdraw the obviousness rejection and allow claim 17 as now worded. It should also be pointed out that claim 13 should now be considered as allowable. Accordingly, claim 17, which depends directly from claim 13, should likewise be deemed to be allowable.

Applicants respectfully submit that claims 7-12 are immediately allowable. Furthermore, the amendment to claims 13 and 17 places these two claims in condition for prompt allowance. All of the remaining non-allowed claims have been canceled from the application to facilitate allowance of the application. The claims are canceled without prejudice to the right of the applicants to recapture the subject matter in one or more subsequent applications. Accordingly, action by the examiner consistent with the indication of allowability is respectfully requested. In the event that any unresolved issues can be handled by phone or e-mail, the examiner is encouraged to do so as promptly as possible by contacting the undersigned.

Respectfully submitted,


James A. Lucas, Reg. No. 21,081
Attorney for Applicant
CUSTOMER NO. 26681

Date: FEBRUARY 1, 2006

JAL:cg